UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,375	08/01/2003	Mikio Uchida	AA540C	4170

7590 03/23/2007

James J. Napoli, Ph.D.
Marshall, Gerstein & Borun LLP
233 South Wacker Drive
6300 Sears Tower
Chicago, IL 60606-6357

EXAMINER	
CHANNAVAJJALA, LAKSHMI SARADA	
ART UNIT	PAPER NUMBER
1615	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/632,375	UCHIDA ET AL.	
	Examiner	Art Unit	
	Lakshmi S. Channavajjala	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 December 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 9-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date ~~9-22-03~~. 2-12-07
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Receipt of RCE, amendment and remarks dated 12-26-06 is acknowledged.

Claims 1 and 9-20 are pending in the instant application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12-26-07 has been entered.

Applicant's arguments with respect to claims 1 and 9-20 have been considered but are moot in view of the new ground(s) of rejection.

The following new rejection is applied to the instant claims:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ

619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 9-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 8-17 of copending Application No. 10/273,815. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending claims directed to an anhydrous cosmetic composition comprising a an inert carrier such as polyethylene glycol and polypropylene glycol, which read on the claimed inert carrier. The copending claims recite the same inorganic heat generating elements of the same particle size, polyoxyalkylene derivatives, and oily conditioning compounds that are also claimed in the instant claims. The copending composition has the same melting point as that of instant claims. The claims of the copending application recite fatty alcohols and esters that read on the instant fatty compounds. Further, the copending composition is used for the same purposes as that of the instant claims. Therefore, the claims of the co-pending claims anticipate the instant claimed composition.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1 and 9-20 are directed to an invention not patentably distinct from claims 1-5 and 8-17 of commonly assigned copending Application No. 10/273,815. Specifically, as explained above, the composition of instant and the copending claims is of identical scope.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 10/273,815, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 9-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/91708 (WO) (submitted on PTO-1449) and US 5,538,720 ('720) in view of JP 06-080534 (submitted on PTO-1449).

WO teaches anhydrous hair conditioning compositions comprising (examples 7-12 on pages 49-50), comprising polypropylene glycol, glutamic acid, Polyquaternium compounds, stearamidopropyl dimethylamine, glutamic acid, cetyl and stearyl alcohol. The above compositions of WO contain only 0.05% water and hence meet the claimed water percentages. WO does not teach the claimed heat-generating agent.

'720 teach an anhydrous composition for hair treatment, particularly hair condition effect, comprising two components that are separated until use and which when mixed with water generates heat (col. 2, lines 38-42). The first component of '720 comprises a physiologically compatible salt that generates heat upon mixing with water and a thickening agent, and the second component comprises at least polyalcohol that is liquid at 25 degrees C (col. 1, lines 30-45). '720 teach that the salts are preferably chloride salts of calcium, magnesium and zinc, which read on the instant heat-generating component (col. 1, lines 43-57). For component B, '720 teach alcohols selected from the group consisting of polyethylene glycol, polypropylene glycol, glycerol, diglycerol etc (col. 2, lines 10-37). '720 further teaches addition of conditioning agents such as cationic

polymers, film-forming agents. The examples listed in col. 3-4 of '720 also recite lactic acid, along with components such as jojoba oil, that meet the claimed acid and inert carrier respectively. While '720 fail to teach magnesium sulfate, '720 differs only in the salt form (magnesium chloride of '720 versus magnesium sulfate of the claims) and absent any unexpected result with the claimed sulfate form, it would have been within the scope of a skilled artisan to choose a magnesium sulfate or magnesium chloride for generating heat in the composition.

JP teaches a cosmetic composition comprising an alcohol such as polyethylene glycol, surfactant and inorganic salt (abstract). JP teaches that polyethylene glycol has the largest hydration and may be mixed with any alcohol so as to obtain the desired heat release. Thus, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to include polyethylene glycol of JP in the composition of WO so as to achieve the sufficient warming of hair (skin), having improved effects and a sufficient heat release value and durability of heat generation. Further, including an inorganic salts (heat generating) of '720 or JP in the composition of WO, either as a single composition or as separate components that can be mixed before use would have been obvious for one of an ordinary skill in the art at the time of the instant invention because '720 suggests that while generating heat, a viscous gel develops that is applied onto the hair where it provides an enhanced conditioning effect due to improved penetration at higher temperature.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 7.00 AM - 4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AU 1615
March 19, 2007

LAKSHMI S. CHANNAVAJJALA
PRIMARY EXAMINER